

Appl. No. 09/694,402
Arndt. Dated 10/22/06
Reply to Office action dated May 24, 2006

Remarks

The Applicant appreciates the Examiner's continued consideration of the present Application. In the Office Action dated May 24, 2006, claims 13 and 20 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness, particularly in view of the preambles of the claims.

Additionally, claims 1-4, 6, 9 and 13-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (U.S. Patent No. 4,831,526) in view of Felton ("Rental Car Insurance: Staying out of financial potholes"). Also, claims 5, 7, 8, 10 and 12 were respectively rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. and Felton, further in view of Cullen et al. (U.S. Patent No. 6,272,528), Mizuno (U.S. Patent No. 6,380,953), Pescitelli et al. (U.S. Patent No. 5,845,256), Official Notice, and Serdy (U.S. Patent No. 5,990,886), respectively.

Further, claims 11 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. and Felton, further in view of Quicken (Quicken website). Finally, claims 15-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen et al. (U.S. Patent no. 6,272,528) in view of Luchs et al. and Felton, and claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over these references further in view of Hartigan (U.S. Patent Application Publication No. 2002/0022976).

In response to the Office action, the Applicant has made certain amendments to the claims as shown above, which are discussed in more detail below. Among these amendments are the cancellation of claims 15-19 and addition of new claims 21-25.

In view of these amendments, and the discussion provided below, the Applicant respectfully submits that the grounds for rejection of claims 1-14 and 20 have been overcome, and that these claims are now in condition for allowance. Additionally, the Applicant respectfully submits that new claims 21-25 are also in condition for allowance.

A) Amendments to the Claims

As shown above, the Applicant has made many amendments to the claims. Among these amendments are changes to the preamble portions of claims 14 and 20,

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such that claim 14 now is an independent method claim and claim 20 is a method claim depending from claim 14.

Also, claim 1 has been amended to broaden the claim language to not require both the input of a temporal limitation and a geographical limitation, but rather to require only the input of a temporal limitation. For at least the reasons set forth below, the Applicant believes that claim 1 is allowable even without the requirement that a geographical limitation be input.

Further, claims 1 and 14 each have been amended to specify that the insurance is to be provided with respect to a customer-owned item, and that information is communicated with respect to a customer-operated terminal. Also, claim 14 has been amended further to include a step of notifying the customer terminal that insurance can be provided when this is the case.

The Applicant additionally has made certain further amendments with respect to the dependent claims as well. Many of these additional claim amendments have been made for technical reasons such as to improve the consistency of the dependent claims vis-à-vis the independent claims, and to correct antecedent basis issues.

As for new claims 21-25, new independent claim 1, like each of claims 1 and 14 relates to a method of providing insurance coverage in which a time limitation concerning the insurance is less than a month, where communication is with a device (which in this claim is a client computer) operated by the customer, and where the insurance concerns a customer-owned item.

The Applicant respectfully submits that the amendments to the claims do not add new matter.

B) Allowability of Claims as Amended

1) Allowability of Claims Under 35 U.S.C. 112

As shown above, independent claim 14 as amended is now a method claim, as are each of claims 13 and 20 depending from that claim. Consequently, the Applicant respectfully submits that the grounds for the rejection under 35 U.S.C. 112 set forth in the

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Office action are no longer applicable and that claims 13 and 20 in particular are not indefinite.

2) Allowability of Independent Claims 1, 14 and 21

The Applicant respectfully submits that, notwithstanding the comments in the most recent Office action, the pending independent claims 1, 14 and 21 are all allowable under 35 U.S.C. 103(a) for at least the reason set forth below.

a) No Suggestion to Combine Luchs and Felton

In the Applicant's previously-submitted Amendment faxed on April 9, 2006, the Applicant argued that there is lacking any suggestion to combine Luchs et al. with Felton to arrive at the Applicant's claimed invention. The Applicant herein repeats all of these arguments since, notwithstanding the comments in the present Office action, the Applicant respectfully submits that no suggestion has been shown to combine those references.

In particular, the Applicant submits that he has carefully reviewed the present Office action for evidence of a suggestion to combine the references, but only has been able to find assertions that such a suggestion to combine exists. For example, on page 4 of the Office action, it is stated “[a]t the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Felton within the method of Luchs with the motivation of allowing a customer to receive insurance only for the period of time in which they are using the rental car”.

The Applicant submits that this does not constitute a showing of a suggestion to combine, but rather constitutes merely an assertion that the prior art can be combined or modified to arrive at the Applicant's claimed invention. Such a statement is insufficient without more to establish *prima facie* obviousness. See MPEP Section 2143.01. Further, the Applicant respectfully reminds the Examiner that “[c]onclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings” to support an obviousness rejection. See MPEP Section 2144.08.

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More particularly, to argue that a suggestion to combine Felton with Luchs et al. exists in those references, one must identify some suggestion that Felton's short-term rental car insurance is applicable for non-rental purposes, or that the system of Luchs et al. pertaining to the insuring of non-rented items is appropriate for use in providing short-term rental car insurance. Yet, as best as the Applicant can determine, these contentions simply are not stated or suggested in either of Felton or Luchs et al. That is, as best as the Applicant can determine, Felton nowhere suggests that short-term rental car insurance is pertinent to anything other than rental cars. Also, as best as the Applicant can determine, Luchs et al. nowhere suggests that its system can be applied to short-term insurance, much less short-term rental car insurance.

Thus, for at least these reasons, the Applicant submits that the Applicant's inventions of claims 1, 14 and 21 are not obvious because Luchs et al. and Felton fail to provide any suggestion for their combination.

b) Secondary Considerations of Graham v. John Deere

In addition to the above reasoning, the Applicant also submits that further rebuttal evidence supporting the nonobviousness of the Applicant's inventions of claim 1, 14 and 21 now has been identified, in the form of the Norwich Union reference ("Short Term Insurance") cited in the most recent Office action. More particularly, the Applicant submits that this reference constitutes evidence of "secondary considerations" indicating nonobviousness, as identified in Graham v. John Deere Co. 383 U.S. 1, 148 USPQ 459 (1966). The Applicant thanks the Examiner for her effort in identifying this relevant material, and respectfully reminds the Examiner that this rebuttal evidence should be considered in analyzing the nonobviousness of the Applicant's invention. See MPEP Section 2144.08.

It should first be noted that, in the Office action, the Norwich Union reference is indicated to be "prior art". Yet the Applicant respectfully submits that, without more, this reference printed in May of 2006 cannot constitute prior art in relation to the present Application filed October 22, 2000. Rather than constituting prior art, the Norwich

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Union reference instead shows how short-term insurance coverage is now an available, distinct insurance product offered on the market.

Further, as best as the Applicant can determine, the Norwich Union reference corresponds directly to the Applicant's invention insofar as it allows customers to purchase up to 28 days of insurance concerning their own automobiles in a variety of circumstances, such as when they are taking delivery of their new vehicle from a dealer (see the section "Benefits"). Additionally, the Norwich Union reference shows that the customer is able to purchase such insurance on-line using their own customer computer. As best as the Applicant can determine, it appears to the Applicant that the four steps of the Applicant's claim 1 invention in particular are shown by the Norwich Union reference or at least are inherently performed when obtaining short-term automobile insurance by visiting the Norwich Union website.

Not only does the Norwich Union reference show that short-term insurance coverage is now available on the market through the use of the Applicant's invention, but also this reference demonstrates that the Applicant's invention is commercially successful, one of the secondary considerations identified in Graham. More particularly, the availability of this product on the Norwich Union website as of May 17, 2006, and continued availability of this product as of October 22, 2006 (when the Applicant revisited the website) constitutes conclusive evidence that enough business is being generated by Norwich Union in relation to this product that they are continuing to offer the product, and consequently that their product corresponding to the Applicant's invention is experiencing commercial success.

Additionally, a clear nexus exists between the method of providing insurance offered by Norwich Union and the Applicant's invention insofar as the insurance offered by Norwich Union is specifically marketed as "short term insurance". That is, the benefit associated with this insurance is that it offers customers the opportunity to purchase insurance that is temporally limited to meet the customers' specific needs, something which also is the focus of the Applicant's invention. Further, it should be noted that the fact that Norwich Union appears to be a company operating in the United Kingdom does not diminish the significance of this evidence of nonobviousness; rather, evidence of

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commercial success is relevant even if the commercial success is taking place abroad.
See MPEP Section 716.03.

In view of this newfound evidence, the Applicant respectfully reminds the Examiner that, according to the MPEP at Section 2144.08, "Office personnel should not evaluate rebuttal evidence for its 'knockdown' value against the *prima facie* case . . . or summarily dismiss it as not compelling or insufficient". Rather, the Applicant respectfully submits that this evidence, in combination with the arguments already set forth above (and in the previous Amendment submitted by the Applicant) concerning the absence of a suggestion to combine Luchs et al. with Felton, is sufficient to demonstrate the nonobviousness of the Applicant's claims 1, 14 and 21.

c) All Claim Limitations Should be Considered

The Applicant also wishes to note that the present claims, as amended, all are method claims and not apparatus claims. Further, the Applicant submits that all of the limitations of the present claims, including the limitations that the item for which insurance coverage is being obtained is customer-owned, help to define the claimed methods and should be considered in evaluating the patentability of the claims.

Thus, while it is suggested on page 22 of the Office action that the requirement of the claims that the item be customer-owned cannot "patently distinguish the claimed invention from the prior art", the Applicant respectfully submits that this conclusion is not appropriate in relation to the presently-pending method claims. Rather, all limitations of a claim, particularly when it is a method claim, should be considered and given weight in evaluating the patentability of the claim.

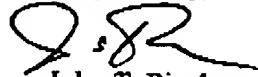
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In view of the above Remarks and Amendments to the Claims, the Applicant respectfully requests reconsideration and allowance of the present Application. The Applicant is also submitting herewith a request for a two-month extension of time and related fee.

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The Examiner is invited to call the Applicant at the telephone number listed below if a telephone conference with the Applicant would further the prosecution of the present Application.

Respectfully,



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